

REMARKS

Claims 1-49 are pending in this application, of which claims 39-49 are withdrawn. Claims 1-38 are rejected. Claims 1-14, 26 and 29 are currently amended. Reconsideration and further examination are respectfully requested.

The examiner objects to the Specification as incorporating essential material by reference. However, the examiner does not identify the essential material that is allegedly missing. Applicant believes that all essential material is explicitly disclosed in the application, i.e., not by reference, and therefore requests reconsideration. If the objection is maintained, Applicant requests that the Examiner clarify the material to be included in the Specification by amendment.

Claims 1-13 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. In particular, the examiner asserts that claims 1-13 recite computer software without the requisite recitation of being stored on a computer-readable medium. Claims 1-13 are currently amended to recite a computer program product stored on a computer-readable medium.

Claims 1, 3-14, 16-27, 29, and 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,681,232 (Sistanizadeh) in view of US Patent No. 7,133,403 (Mo). With regard to the recited claim limitation of selecting a communication path based at least in-part on the network information related to the communication services, the examiner cites Sistanizadeh at column 18, lines 17-35. In particular, the examiner asserts that OSPF is analogous to the claim limitation. OSPF is a network protocol for resolving the "best" path in terms of number of hops. However, the best path for a particular application is not always defined by the fewest number of hops. For example, the path with the fewest number of hops might have limited bandwidth or other problems causing it to be unsuitable for a particular

application having particular bandwidth, latency, jitter or other requirements. When the application is hosted by the carrier, network engineers will consider application requirements when designing and configuring the network. In other words, application requirements can be considered well in advance of implementation because those requirements are known to the carrier. Nevertheless, it is well known that large lead time for provisioning of some services is a problem for customers. Even provisioning a common service such as T1 access to an enterprise can take weeks. In some cases the problem is only associated with first time setup, e.g., a “nailed up” T1 to an enterprise at a new site. However, the problem becomes more acute when the application requires quick network provisioning in order to function properly, particularly a user application, i.e., an application that is not hosted by the carrier, because the carrier does not have advance knowledge of user requirements. Indeed, even the user may not have advance knowledge of application requirements because those requirements may develop in real time. Examples of such application requirements include occasional mass data transfer associated with research applications and remote data backup. Carriers are not prepared to accommodate a user application that requires provision of, e.g., OC12 service for a short duration at any time on five minutes advance notice to a previously unspecified peer. The present invention helps to solve these problems while shielding the user from carrier network topology. As described at page 13, lines 9-10, page 12, lines 12-19 (referencing Figure 4), and page 15, lines 4-8 and 17-23 (referencing Figure 7), the path is not simply selected based on number of hops or other metrics based on network efficiency, but by evaluating user requirements. In particular, the agent “understands user requirements,”¹ and “manages communication services on behalf of the user, specifically by requesting communication services from the ASON 120 via the OSA-N and

¹ page 13, lines 9-10

mapping communication services from the ASON 120 to the user network or application.”²

Independent claims 1, 14, 26 and 29 are currently amended to emphasize this distinction. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Withdrawal of the rejections of claims 1, 3-14, 16-27, 29, and 31-38 is therefore requested.

In addition to the distinction described above, the cited combination is improper because (a) there cannot be a motivation to combine where the combination defeats the operation of one teaching; and (b) the combination does not actually yield the claimed invention. The Office concedes that Sistanizadeh fails to teach managing optical communication paths for the user without exposing network topological information to the user. However, the Office asserts that Mo teaches shielding the topology from the user at column 3, lines 9-13. Carriers have traditionally shielded their network topology from users and peers. However, shielding topology limits customized provisioning of services. The references are fundamentally contradictory because Sistanizadeh relies upon revealing the intervening network topology to the user in order to customize services. In section “D. Service Level Manager (SLM) - Preferred implementations” Sistanizadeh teaches that agents capture data indicative of network performance, and that data is utilized in conjunction with topological information for service level management. Sistanizadeh plainly states that “the user interface is accessible both by carrier staff personnel and by end-user customers,”³ and that “the service level manager provides an understanding of the topology of the network.”⁴ If the network topological information were withheld, as the Office suggests would result from combining Sistanizadeh with Mo, then

² page 15, lines 20-23

³ Sistanizadeh at column 2, lines 50-53

Sistanizadeh would be unable to perform the described service level management, i.e., the teaching would become inoperable. The cited combination is therefore improper because (a) there cannot be a motivation to combine where the combination defeats the operation of the teaching; and (b) the combination does not actually yield the claimed invention. Withdrawal of the rejection is therefore again requested.

Claims 2, 15, 28 and 30 are rejected under 35 U.S.C. 103(a) based on Sistanizadeh in view of Mo and in further view of US Patent No. 7,095,956 (Levandovsky). These dependent claims include additional limitations beyond those in the independent claims, and are allowable for the same reasons already stated above. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Withdrawal of the rejections of claims 2, 15, 28 and 30 is therefore requested.

⁴ Sistanizadeh at column 17, lines 65-66

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited. Should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney at the number listed below so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date

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